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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,664	12/20/2001	Stuart J. Solomon	12587-022001 / 01316-00/U	1128
26212 7590 09/21/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/027,664

Applicant(s)

SOLOMON ET AL.

Examiner

Igor N. Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-15 and 35-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-15 and 35-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 07/06/2007 is acknowledged and entered. Claims 1, 6, 11, and 36 have been amended. Claims 1, 3-6, 8-11, 13-15 and 35-51 are currently pending in the application.

Claim Rejections under 35 USC § 112 and 35 USC § 101 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8-11, 13-15 and 35-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 2002/0169664) in view of Gharavy (US 2003/0004840).

Walker et al. (Walker) teaches a method and system for providing offers using a billing statement, comprising:

Claim 36.

Receiving electronically, at a computer system, a first transaction record from an organization, the first transaction record being received according to a first protocol, and the first transaction record having a first format and including first transaction data stored in the first format and describing a completed first transaction between the organization and a customer [0033];

formatting data according to the Common Gateway Interface (CGI) format or another format for passing data from a network client to a server [0048];

accessing, by the computer system and based on information in the first transaction record, a first business rule configured by the organization and describing a second transaction expected to be completed between the organization and the customer in response to the completed first transaction [0192]; [0155]; [0157];

waiting, by the computer system, for reception of a second transaction record from the organization including second transaction data describing completion of the second transaction [0033].

Walker does not explicitly teach that said formatting data includes converting, by the computer system, the first transaction data from the first format into another format.

Gharavy teaches a method and system for performing collective validation of credential information, comprising: during said validation of transmitted data, converting data format in the format usable by the rule engine, for example *standard format* [0025]; [0105].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include converting, by the computer system, the first transaction data from the first format into another format, as disclosed in Gharavy, because it would advantageously simplify the processing of said data, as well as allow to accommodate clients executed on various platforms. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 37-38. See reasoning applied to Claim 36. Furthermore, teachings of Walker in view of Gharavy would allow the repetition of the recited steps.

Furthermore, Walker teaches:

Claim 39-40,

receiving the second transaction record from the organization, the second transaction record being received according to the first protocol, and the second

transaction record having the first format and including the second transaction data stored in the first format and describing a completed second transaction between the organization and the customer [0033];

determining whether the first business rule is satisfied by the second transaction data; and informing the organization of whether the first business rule is satisfied [0192]; [0155]; [0157]. (As per formatting step per se see reasoning applied to claim 36).

Claim 41. Receiving a third transaction record from the organization, the third transaction record being received according to the first protocol, and the third transaction record having the first format and including the third transaction data stored in the first format and describing a completed third transaction between the organization and the customer [0033];

determining that the third transaction is an unexpected (additional) transaction, an unexpected (additional) transaction being a transaction that is expected to succeed a given transaction that has not been completed; and informing the organization that the third transaction is an unexpected (additional) transaction [0192]; [0155]; [0157]. (As per formatting step per se see reasoning applied to claim 36).

Claim 42. Receiving a third transaction record from another organization, the third transaction record being received according to another protocol, and the third transaction record having another format and including third transaction data stored in the another format and describing a completed third transaction between the another organization and another customer [0033];

accessing, based on information in the third transaction record, a third business rule configured by the another organization and describing a fourth transaction expected to be completed between the another organization and the another customer in response to the completed third transaction [0192]; [0155]; [0157];

waiting for reception of a fourth transaction record from the another organization including fourth transaction data describing completion of the fourth transaction [0033]. (As per formatting step per se see reasoning applied to claim 36).

Claims 43-44. Receiving the fourth transaction record from the another organization, the fourth transaction record being received according to the another protocol, and the fourth transaction record having the another format and including the fourth transaction data stored in the another format and describing a completed fourth transaction between the another organization and the another customer [0033];

determining, by the computer system, that the third business rule is satisfied by the fourth transaction data [0048];

accessing, based on the third business rule being satisfied, a fourth business rule configured by the another organization and describing a fifth transaction expected to be completed between the another organization and the another customer in response to the completed fourth transaction [0192]; [0155]; [0157];

waiting for reception of a fifth transaction record from the another organization including fifth transaction data describing completion of the fifth transaction. (As per formatting step per se see reasoning applied to claim 36).

Claims 45-47. See reasoning applied to Claim 36. Furthermore, teachings of Walker in view of Gharavy would allow the repetition of the recited steps.

Claims 48-51. See reasoning applied to Claim 36. Information as to the specifics of the organization cannot change the method steps recited, therefore cannot distinguish said method steps from the prior art in terms of patentability.

Walker teaches a method and system for providing offers using a billing statement, comprising:

Claims 1, 6 and 11.

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Providing business rules which are configured by a market participant (user) [0155];

receiving offer including a transaction-related information (portion) and specified amount which is to be charged during said transaction if said offer is accepted (expected related response portion) [0033];

formatting data according to the Common Gateway Interface (CGI) format or another format for passing data from a network client to a server [0048];

receiving information related to an acceptance for the offer (expected related response) [0157];

matching information related to an acceptance (expected related response) with alternative offer related to the same transaction (transaction-related portion) [0157];

determining whether said received information satisfies at least one configurable business rule [0192], wherein the configurable business rule specifies a relationship between the received business transaction and the subsequent business transaction [0192]; [0155]; [0157];

establishing information related to subsequent business transaction based on said determination [0192]; [0155]; [0157].

Walker does not explicitly teach that said formatting data includes converting, by the computer system, the first transaction data from the first format into another format.

Also, Walker does not specifically teach *validating said information related to at least on business transaction; communicating to the first market participant validation results of said at least on business transaction; and enabling the market participant to track a status of said information related to the business transaction and the subsequent business transaction.*

Gharavy teaches said method and system for performing collective validation of credential information, wherein:

credential data of a transaction is *validated* [0025]; [0105];

during said validation said data is *converted* in the format usable by the rule engine, for example *standard format* [0025]; [0105];

tracking information related to said credential data [0030].

Furthermore, Gharavy teaches that the transaction is approved based on the successful validation results, thereby indicating *communicating to market participants validation results of said at least on business transaction* (Fig. 4; [0125]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include validating said information related to at least on business transaction; and tracking information related to said credential data, as disclosed in Gharavy, because it would advantageously enhance accuracy of the system, and make it more secure. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include that said data is converted in the standard format, as disclosed in Gharavy, because it would advantageously simplify the processing of said data, as well as allow to accommodate clients executed on various platforms. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 3, 8 and 13. Walker teaches said method and system, wherein the configurable business rule is configured based on at least one of a jurisdiction associated with the received business transaction, a time relationship between the received business transaction and a subsequent business transaction, and a business event associated with the received business transaction [0162].

Claims 4, 9 and 14. Walker teaches processing business transactions representing different formats [0048].

Claims 5, 10 and 15. Walker teaches rejecting a requested transaction if this transaction does not satisfy business rules [0093].

Claim 35. Walker in view of Gharavy teaches all the limitations of Claim 35, except specifically teaching a second processor configured to access the processor. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker and Gharavy to include a second processor configured to access the processor, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments filed 07/06/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that Walker fails to disclose *receiving a second transaction record from an organization that configured a business rule, the second transaction record describing completion of a second transaction between the organization and a customer*, it is noted that Walker teaches said feature. Specifically, Walker teaches, that after conducting a *first* transaction, the consumer is offered to conduct a *second* transaction (accepting the reviewed offer; the reviewed offer specifying (business rules) that the consumer's account balance will be reduced by the amount owed as a result of the transaction in exchange for performance of an obligation) [0033].

In response to applicant's argument that the prior art fails to disclose "receiving electronic data from the first market participant in a first format representing the business transaction" and "validating the electronic data representing the business transaction", it is noted that Walker teaches communicating to the first market participant formatted electronic data representing the business transaction. Gharavy was applied for "validation" feature. Specifically, Gharavy teaches validating credential data representing a transaction [0025]; [0105].

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

Conclusion

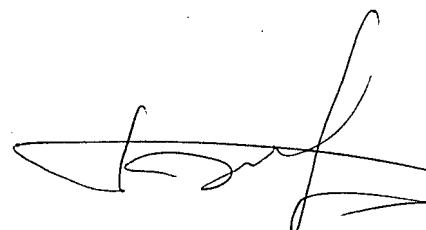
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
09/17/2007



IGOR N. BORISSOV
PRIMARY EXAMINER